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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,264	06/05/2001	Toru Uchida	010726	6047

23850 7590 08/13/2003

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EXAMINER

BAUMEISTER, BRADLEY W

ART UNIT

PAPER NUMBER

2815

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**Application No.  
**09/873,264**Applicant(s)  
**Uchida et al.**Examiner  
**B. William Baumeister**Art Unit  
**2815**

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jul 28, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: At least the proposed amendment to independent claim 1--newly setting forth that the compressive strain exceeds 0.25%--requires further consideration and search.

3. ☐ Applicant's reply has overcome the following rejection(s):  
\_\_\_\_\_  
\_\_\_\_\_
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
\_\_\_\_\_  
\_\_\_\_\_
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: 1-15
- Claim(s) withdrawn from consideration: 16 and 17 *BMB*

8. ☒ The proposed drawing correction filed on 7/28/03 is a) ☒ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

10. ☒ Other: See the attachment addressing Applicant's arguments relating to the propriety of the last Office Action's finality.

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**ADVISORY ACTION**

***Response to Arguments***

1. Applicant's arguments filed 7/28/2003 have been fully considered but they are not persuasive.

a. Applicant asserts that the finality of the last Office Action (paper #11) was premature because the Examiner's rejection was based upon the new application of a prior-art reference that was previously made of record. Applicant asserts that the issuance of the finality is therefore a clear violation of procedural fairness.

b. However, the test for whether it is proper to make an Office action final is NOT whether a newly-applied prior-art reference potentially could have been applied in a previous rejection. Rather, the relevant test for whether it is proper to make an Office action final is whether the new rejection was necessitated by Applicant's amendment. See MPEP §706.07(a), governing the finality of an Office Action. In the present case, the second rejection was necessitated by Applicant's previous claim amendments set forth in Amendment A (paper #10) filed 2/24/2003. Thus, finality was proper.

c. Further, MPEP §706.07(a) makes it clear that such a second or subsequent action could be made final even if the newly cited prior-art was not previously made of record: i.e., even if Applicant had no opportunity to review the newly-applied prior-art reference. Thus, it cannot be said that it would be procedurally unfair to make final a rejection that is based on a prior-art reference of which Applicant actually did, in fact, have prior knowledge since, in such a case,

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Applicant did have an opportunity to review the reference prior to making desired amendments to the claims.

d. Finally, if Applicant's argument is to be construed to mean that the finality provisions of MPEP §706.07(a) violate the Constitution's procedural due process requirements, it is noted that the Examiner is not an Article III judge and therefore does not have the authority to decide such constitutional issues.

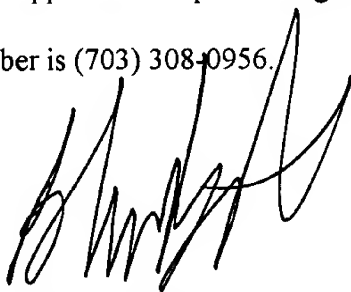
#### INFORMATION ON HOW TO CONTACT THE USPTO

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, **B. William Baumeister**, at **(703) 306-9165**. The examiner can normally be reached Monday through Friday, 8:30 a.m. to 5:00 p.m. If the Examiner is not available, the Examiner's supervisor, Mr. Eddie Lee, can be reached at (703) 308-1690. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

B. William Baumeister

Primary Examiner, Art Unit 2815

August 11, 2003



B. WILLIAM BAUMEISTER  
PRIMARY EXAMINER